

REMARKS

Claims 5-10, 13-17, 20, 25-30, 33, 37 and 42-43 are pending in the instant Application. In the most recent Office Action, claims 37, 42 and 43 are rejected under 35 U.S.C. § 101 as allegedly reciting non-statutory subject matter. Further, the Office Action repeats the rejections made in the Office Action mailed 02 November 2004, without regard to Applicants amendments filed 02 February 2005.

By the above amendments, claims 37, 42 and 43 are recite "A computer-readable medium tangibly embodying an image search program" consistent with the Examiner's prescription in the Office Action. No new matter has been added by this amendment. Favorable reconsideration and withdrawal of the rejection of these claims as non-statutory subject matter is kindly requested.

Turning to the copied rejections, Applicant respectfully submits that the Office Action fails to make out a *prima facie* case of obviousness with respect to the amended claims. As presented with the previous amendment,

As amended above, claim 5 incorporates subject matter previously recited in claims 1, 18 and 19. Claim 13 is amended to incorporate subject matter previously recited in claims 1, 11, 18 and 19. Claim 25 is amended to incorporate subject matter previously recited in claim 21. Claim 33 is amended to incorporate subject matter previously recited in claims 21 and 31. Claim 37 is amended to incorporate subject matter previously recited in claim 34. Claim 43 is amended to incorporate subject matter previously recited in claims 34 and 41.
(Amendment filed 02 February 2005, p. 25)

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See, In re*

Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, as presented in the previous Office Action (and repeated in the most recent Office Action), claim 1 is rejected over Shiiyama and Matsuzaki; claim 5 over Shiiyama, Matsuzaki, Kusama and Abe; claim 18 over Shiiyama, Matsuzaki, Kusama, Abe and Takata; claim 19 over Shiiyama, Matsuzaki and Nakagawa. There is no single statement of rejection that purports to address all features recited in independent claim 5 as it was amended prior to the most recent Office Action. Therefore, no proposed combination of references, even presuming their combination is proper, reaches claim 5. Similar ambiguity exists at least with respect to independent claims 13. As previously amended, claims 6-10, 14-17 and 20 depend, either directly or indirectly, from claim 5. The ground of rejection of these claims is similarly unclear.

Moreover, the verbatim repetition of rejections no longer applicable to the claims in light of subsequent amendments thereto fails to meet the Office burden of setting forth its reasons for rejection, and denies Applicant of the ability to effectively respond thereto. The Courts have held that an Office Action fails to make out a *prima facie* case where it does not sufficiently explain the reasons for the rejection to permit a rational isolation and determination for the legal issues that may be present. *See, In re Herrick*, 145 USPQ 400 (CCPA 1965); *Ex Parte Blanc*, 13 USPQ2d 1383 (BPAI 1989). Such rejections cannot be and are not sustained.

At the minimum, Applicant respectfully submits that in light of the state of the most recent Office Action, it was prematurely made final, not in compliance with 37 C.F.R. § 113(b). Section 113(b) states "In making [a] final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in

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the application, clearly stating the reasons in support thereof." In this case, the final rejection fails to state the grounds of rejection applicable to the amended claims, and fails to set forth any reasons for rejection as applicable to the amended claims.

Therefore, Applicant respectfully submits that the Office Action has failed to make a *prima facie* rejection of the amended claims over the applied prior art, and kindly requests that the rejections be favorably reconsidered and withdrawn. Further, Applicant respectfully submits that the Office Action was prematurely made final, in view of 37 C.F.R. § 113(b). Withdrawal of finality is kindly requested. If the Examiner has any reservation in allowing the claims, and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully Submitted,



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